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**THIS DISPOSITION  
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Paper No. 10

HRW

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re VisualGold.com, Inc.

Serial No. 76/023,196

Michael S. Sherrill of Sherrill Law Offices  
for VisualGold.com, Inc.

Brendan Regan, Trademark Examining Attorney, Law Office 113  
(Odette Bonnet, Managing Attorney).

Before Cissel, Wendel and Bucher, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

VisualGold.com, Inc. has filed an application to  
register the mark IMAGIST for "computer programs for use in  
enhancing and compressing electronic images transmitted via  
a global computer network."<sup>1</sup>

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<sup>1</sup> Serial No. 76/023,196, filed January 27, 2000, based on an  
allegation of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark IMAGIST, which is registered for "computer hardware and software imaging processing and analyzing system; namely, work station, interface electronics, disk drives, optical disk drives, and image input devices including cameras and monitors for use with light and electron microscopy."<sup>2</sup>

The refusal has been appealed and applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*<sup>3</sup> factors that are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods with which the marks are being used, or are intended to be used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

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<sup>2</sup> Registration No. 1,781,134, issued July 13, 1993, Section 8 & 15 affidavits accepted and acknowledged, respectively.

<sup>3</sup> *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Insofar as the marks are concerned, there is no question but that the marks are identical. There is no difference whatsoever in overall commercial impression, and applicant has made no argument to the contrary.

Thus, the major issue for consideration here is the similarity or dissimilarity of the respective goods. Before making this comparison, we note that in general the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products on which they are being used, or are intended to be used, in order to support a holding of likelihood of confusion. If the marks, as here, are the same, it is only necessary that there be a viable relationship between the goods in order to find confusion likely. See *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983). Moreover, it is not necessary that the goods of applicant and registrant be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from, or are associated with, the same source.

See In re Albert Trostel & Sons, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein.

Applicant contends that the goods of applicant are quite different in nature from those of registrant and are used for different purposes. Applicant argues that the specific function of applicant's goods is to "provide quality compression and enhancement of an existing image to be transmitted and viewed over a global computer network," whereas the function of registrant's goods is to "generate an image created with an electron microscope." (Brief p. 5). Applicant further argues that its goods are used by Web developers, Internet service providers and content providers to enhance and compress images to be used in Web-based applications, while registrant's goods would be used in conjunction with electron microscopes, which are highly sophisticated pieces of scientific equipment and are typically purchased by universities, laboratories, research hospitals and large corporations.

The Examining Attorney argues that not only are both applicant's and registrant's software concerned with digital images, but also, because applicant has not made any specification as to field of use in the identification of its goods, it can be assumed that applicant's goods may be used in registrant's particular field of electron

microscopy. He further argues that the fact that applicant's images are to be "transmitted via a global computer network" fails to distinguish them from registrant's goods or to define a particular, discrete field of use. Finally, he points out that, by definition, the "image enhancing" function of applicant's goods is virtually synonymous with the "image processing" function of registrant's goods; both involve image improvement.

While both applicant's and registrant's goods are software and both involve image processing or improvement, our analysis clearly cannot stop at this point. Registrant's software is specifically directed to use in conjunction with light and electron microscopy and the images coming from such a source. Applicant's software, by contrast, deals with pre-existing images which are to be transmitted via a global computer network. The problem with applicant's attempt to distinguish the goods on the latter basis, however, is that, as pointed out above, the goods of applicant and registrant need not be the same or competitive. The question is simply whether there is a viable relationship between the goods such that the use of the same mark on both would lead prospective purchasers to believe, mistakenly, that the same source is responsible for both.

Here we find such a relationship exists in that there is no reason why, as identified, the software of applicant could not be used to further enhance and compress the images generated by registrant's software for ultimate transmission via a global computer network. Thus, if the respective products bearing the identical mark IMAGIST were encountered by similar purchasers, these persons might well assume that these were companion products emanating from the same source.

Although applicant attempts to distinguish the channels of trade and the relevant buyers for the respective software products, there are no restrictions in the application which would preclude the sale of applicant's goods to institutions involved with electron microscopy as well as to the Web-associated purchasers listed by applicant. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992)(if there are no restrictions in the application, it must be presumed that the goods travel in all the normal channels of trade for goods of this nature). While registrant's software may be limited in application and channels of trade, the same does not hold true for applicant's.

Applicant also argues that the purchasers of both types of software are sophisticated knowledgeable

professionals who would exercise careful consideration in their purchases. We find no evidence of record, however, to support these assertions. Furthermore, even careful purchasers are not immune from source confusion, particularly when the marks used on the products are identical and a viable relationship exists between the goods. See *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

Accordingly, we find confusion likely. To the extent that there may be any remaining doubt, we follow the well-established principle that any doubt regarding likelihood of confusion must be resolved in favor of the registrant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) is affirmed.

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